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Rui Yuge

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EXAMINER

KIM, TAEYOON

ART UNIT

PAPER NUMBER

1651

MAIL DATE

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/574,816	Applicant(s) YUGE ET AL.	
	Examiner TAEYOON KIM	Art Unit 1651	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 June 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 54,55 and 59-62 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 54,55 and 59-62 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>7/17/09</u> . | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

Applicant's amendment and response filed on 6/24/2009 has been received and entered into the case.

Claims 1-54, 57, 58 and 63 are canceled, and claims 55, 56 and 59-62 are pending and have been considered on the merits. All arguments have been fully considered.

The claim rejection under 35 U.S.C. §103 has been withdrawn due to the new ground of rejection.

Applicant's arguments with respect to claim rejection based on Pickard have been considered but are moot in view of the new ground(s) of rejection.

Claim Objections

Claim 55 is objected to because of the following informalities: Claim 55 discloses a Markush type species in lines 15-18. It would be more appropriate for the Markush group as "a porous film made of one or more selected from the group consisting of ..." Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 55, 56 and 59-62 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The term "syringe-type" in claim 55 is not clear what subject matter the term intends to point out. M.P.E.P. §2173.05(b) states that the addition of the word "type" to an otherwise

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definite expression (e.g., Friedel-Crafts catalyst) extends the scope of the expression so as to render it indefinite. *Ex parte Copenhaver*, 109 USPQ 118 (Bd. App. 1955). Likewise, the phrase "ZSM-5-type aluminosilicate zeolites" was held to be indefinite because it was unclear what "type" was intended to convey. The interpretation was made more difficult by the fact that the zeolites defined in the dependent claims were not within the genus of the type of zeolites defined in the independent claim. *Ex parte Attig*, 7 USPQ2d 1092 (Bd. Pat. App. & Inter. 1986).

The term "a fluid handling medium" in claim 55 is vague. It can be interpreted as to the medium that can handle fluid or the handling medium is fluid.

The phrase of "being at least partially composed of a main body" in line 3 of claim 55 is not clear what the phrase points out to claim. It is vague whether the vessel and the main body is different entity or the same (e.g. the main body with the plunger forms the vessel). It can be interpreted such that the vessel is connected to the main body or the vessel can be the main body. It appears that the vessel is the main body in this particular configuration of the claimed invention. Clarification is required.

Applicant is recommended to use the term "main body" for the "vessel" since it appears that these two terms are used interchangeably.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 55, 56, 59-62 are rejected under 35 U.S.C. 103(a) as being unpatentable over

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Alchas (US 4,772,273).

Alchas teaches an vented container comprising a housing having a chamber for retaining fluid, and venting means communicating between the chamber and the exterior of the housing, allowing air to enter the housing as fluid leaves the chamber through the passageway (mouth) a closing member (a closure or tip cap; #62 of Figs. 4 and 5) and a plunger (Figs. 6 and 7). The venting means of Alchas includes an air-permeable liquid-impermeable element such as polytetrafluoroethylene, polyester, polypropylene or polyethylene (col. 13, lines 37-40).

Although Alchas does not teach the intended use of the device to hold handling medium containing cells, since Alchas discloses that the device of Alchas is for therapeutic liquid, it is considered that the device is suitable for fluids containing cells.

With regard to the limitation of oxygen permeability, since the material used for the porous membrane in the vent of the Alchas' device is the same as one used in the claimed invention, it is considered that the porous membrane of Alchas has the same property as the porous film of the claimed invention.

M.P.E.P. § 2112.01 recites, "Products of identical chemical composition can not have mutually exclusive properties. A chemical composition and its properties are inseparable. Therefore, if the prior art teaches the identical chemical structure, the properties applicant discloses and/or claims are necessarily present." See *In re Spada* (citations omitted).

With regard to the position of the gas permeable region being formed in the surface of the vessel that makes contact with the plunger when the plunger is in the fully pressed state, Alchas teaches the vent being formed on the surface next to the passageway (discharge part) (see Fig. 1).

With regard to the position of the gas permeable region being formed in the main body,

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Alchas teaches the vent being formed on the barrel of the device as shown in Figure 4 (#59) (see also col. 6, line 68 through col. 7, line 3).

Although the shape of the gas permeable region on the barrel (housing) of Alchas' device is not as those claimed in claim 59, it is considered that the limitation is merely a design change. It is well established by the court that the change of design is obvious. *In re Dailey*, 357 F.2d 669, 149 USPQ 47 (CCPA 1966) (The court held that the configuration of the claimed disposable plastic nursing container was a matter of choice which a person of ordinary skill in the art would have found obvious absent persuasive evidence that the particular configuration of the claimed container was significant.). See M.P.E.P. §2144.04.

Furthermore, the number of a permeable region formed on the main body can be easily duplicated for the same purpose. M.P.E.P. §2144.04 states “*In re Harza*, 274 F.2d 669, 124 USPQ 378 (CCPA 1960) (Claims at issue were directed to a water-tight masonry structure wherein a water seal of flexible material fills the joints which form between adjacent pours of concrete. The claimed water seal has a “web” which lies in the joint, and a plurality of “ribs” >projecting outwardly from each side of the web into one of the adjacent concrete slabs. <The prior art disclosed a flexible water stop for preventing passage of water between masses of concrete in the shape of a plus sign (+). Although the reference did not disclose a plurality of ribs, the court held that mere duplication of parts has no patentable significance unless a new and unexpected result is produced.)”.

With regard to the closing member (closure or tip cap) having a gas permeable region, Alcha does not teach the limitation. However, it would have been obvious to a person of ordinary skill in the art to form a gas permeable region on the closure or tip cap of Alchas' device because

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the vent formed on the housing of the device can be formed any part of the device to facilitate gas exchange and a person of ordinary skill in the art would recognize that the closure or tip cap is another portion to have a gas permeable region for the same purpose of other gas permeable regions on the device.

Therefore, the invention as a whole would have been prima facie obvious to a person of ordinary skill at the time the invention was made.

Conclusion

No claims are allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to TAEYOON KIM whose telephone number is (571)272-9041. The examiner can normally be reached on 8:00 am - 5:00 pm ET (Mon-Thu).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Wityshyn can be reached on 571-272-0926. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Taeyoon Kim/
Primary Examiner, Art Unit 1651